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EXAMINER

RADA, ALEX P

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,743

Applicant(s)

CHAMBERLIN, JAMES L.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-18 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18 and 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. Attached hereto.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

In response to the amendment filed January 28, 2005 in which the applicant previously canceled claims 1-14 and 19-23, amends claims 15-18, adds new claim 32, and claims 15-18 and 24-32 are pending in this office action.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in tow-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 32 is within the technological art because it employs a methodology a personal computer system.

Useful, Concrete and Tangible Analysis

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, the method and apparatus of striking or squeezing a contact element to relieve stress does not provide a concrete and tangible result. The mere striking or squeezing a contact element like a punching bag does not render the same result for each and every user. The method claimed as a whole does not produce a concrete and tangible result.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15, 17, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue (4,953,852) in view of Drain (4,693,443), Brown et al. (6,133,823), and Ting (US 5,211,282).

3. Donohue discloses the following:

A substantially rigid support having a first end and a second end (figures 1 and 3), a contact element connected at or near the second end of the support

(figures 1 and 3), and the contact element is a punching bag (figures 1 and 3) as recited in claim 15.

A contact element connected to the support, the support is an elongated, rigid member having at least one connector, and the contact element is a punching bag and is movably connected to the support at a position spaced from the connector as recited in claim 17.

The punching bag is movably connected to the support (figures 1 and 3) as recited in claim 25.

Donohue does not expressly disclose the following:

The first end being connectable with a desktop computer monitor as recited in claim 15.

The at least one connector configured to engage at least one engagement element on the computer component as recited in claim 17.

The support is an elongated plastic member as recited in claim 26.

Drain teaches the following:

The first end connectable with a desktop computer monitor, since it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform, in which Drain teaches the first end connectable with a desktop computer monitor (figures 5-7 and column 5, line 6 – column 6, line 3) as recited in claim 15.

The at least one connector configured to engage at least one engagement element on the computer component, since it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but

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only requires the ability to so perform, in which Drain teaches the at least one connector configured to engage at least one engagement element on the computer component (figures 5-7 and column 5, line 6 – column 6, line 3) as recited in claim 17. By having a connectable member configure to be mounted to a desk top monitor, one of ordinary skill in the art would provide a secure and detachably attached mounting device to the side of a computer console or the like.

Donohue and Drain do not expressly disclose the following:

The contact element includes a sound-producing device in side the punching bag such that a pre-recorded sound is emitted when the punching bag is struck as recited in claims 15 and 17.

Brown et al teaches the following:

The contact element includes a sound-producing device having pre-recorded sound when activated concealed within a body (summary and figures 1-3) as recited in claims 15 and 17. By having a sound-producing device having pre-recorded sound when activated and concealed within a body, one of ordinary skill in the art would provide a novelty device that produces a variety of audible sounds in a variety of modes.

Ting teaches the following:

A squeezing device having a sound-producing device concealed within plush toy as recited in claims 15 and 17. By having a sound-producing means inside the body of a device, one of ordinary skill in the art would provide an inexpensive and easy to use mechanism capable of being activated in force or impact is applied to any one of a plurality of directions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the substantially rigid elongated support having a first end of Donohue to include a connectable member configured to be mounted to a desk top monitor as taught by Drain, a sound producing device having pre-recorded sounds when activated and concealed within a body as taught by Brown and Ting to provide a secure and detachably attached mounting device to the side of a computer console or the like and a novelty device that produces a variety of audible sounds in a variety of modes.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the support be made of plastic because any piece of material would provide the same support as taught by Drain, since Applicant has not disclosed that the support is an elongated plastic member as recited in claim 26 provides an advantage or solves a stated problem.

4. Claim 16 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue (4,953,852) in view of Drain (4,693,443).
5. Donohue discloses the following:

A substantially rigid support having a first end and a second end (figures 1 and 3), a contact element movably connected at or near the second end of the support (figures 1 and 3), the contact element is a punching bag, and the support is configured to maintain the punching bag at a spaced position (figures 1 and 3) as recited in claim 16.

The punching bag depends from the support (figures 1 and 3) as recited in claim 28.

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Donohue does not expressly disclose the following:

The first end being connectable with a desktop computer monitor as recited in claim 16.

Drain teaches the following:

The first end connectable with a desktop computer monitor and the support is configured to maintain a spaced position from the monitor, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform, in which Drain teaches the first end connectable with a desktop computer monitor and the support configured to maintain a spaced position from the monitor (figures 5-7 and column 5, line 6 – column 6, line 3) as recited in claim 15. By having a connectable member configured to be mounted to a desk top monitor, one of ordinary skill in the art would provide a secure and detachably attached mounting device to the side of a computer console or the like.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the support of the first end of Donohue to include a connectable member configured to be mounted to a desk top monitor as taught by Drain to provide a secure and detachably attached mounting device to the side of a computer console or the like.

6. Claim 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue (4,953,852) in view of Drain (4,693,443) and Fotsis (6,234,940).

7. Donohue discloses the following:

A substantially rigid support having a first end and a second end (figures 1 and 3), a contact element connected at or near the second end of the support (figures 1 and 3), and the contact element is a punching bag (figures 1 and 3) as recited in claim 18.

The punching bag is movably connected to the support (figures 1 and 3) as recited in claim 31.

Donohue does not expressly disclose the following:

The first end being connectable with a desktop computer monitor as recited in claim 18.

Drain teaches the following:

The first end connectable with a desktop computer monitor and the support is configured to maintain a spaced position from the monitor, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform, in which Drain teaches the first end connectable with a desktop computer monitor and the support configured to maintain a spaced position from the monitor (figures 5-7 and column 5, line 6 – column 6, line 3) as recited in claim 18. By having a connectable member configured to be mounted to a desk top monitor, one of ordinary skill in the art would provide a secure and detachably attached mounting device to the side of a computer console or the like.

Donohue and Drain do not expressly disclose the following:

The punching bag having display indicia as recited in claim 18.

Fotsis teaches the following:

The punching bag having display indicia (figure 1, column 4, lines19-31, and column 5, lines 53-65) as recited in claim 18. By having display indicia on a punching bag, one of ordinary skill in the art would increase the enjoyment of the device by providing a picture of an opponent.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the support of the first end of Donohue to include a connectable member configure to be mounted to a desk top monitor as taught by Drain and the punching bag displaying indicia as taught by Fotsis to provide a secure and detachably attached mounting device to the side of a computer console or the like and to increase the enjoyment of the device by providing a picture of an opponent.

8. Claims 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue (4,953,852) in view of Drain (4,693,443) and Brown et al. (6,133,823) as applied to claims 15 and 17 above, and further in view of Fotsis (6,234,940).

9. Donohue in view of Drain and Brown disclose the claimed invention as discussed above except for the following:

The punching bag having display indicia as recited in claims 24 and 29.

Fotsis teaches the following:

The punching bag having display indicia (figure 1, column 4, lines19-31, and column 5, lines 53-65) as recited in claims 24 and 29. By having display indicia on a punching bag, one of ordinary skill in the art would increase the enjoyment of the device by providing a picture of an opponent.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Donohue to further include display indicia on a punching bag as taught by Fotsis to increase the enjoyment of the device by providing a picture of an opponent.

10. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue (4,953,852) in view of Drain (4,693,443) as applied to claim 16 above, and further in view of Fotsis (6,234,940).

II. Donohue in view of Drain disclose the claimed invention as discussed above except for the following:

The punching bag having display indicia as recited in claim 27.

Fotsis teaches the following:

The punching bag having display indicia (figure 1, column 4, lines 19-31, and column 5, lines 53-65) as recited in claim 27. By having display indicia on a punching bag, one of ordinary skill in the art would increase the enjoyment of the device by providing a picture of an opponent.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Donohue to further include display indicia on a punching bag as taught by Fotsis to increase the enjoyment of the device by providing a picture of an opponent.

Response to Arguments

12. Applicant's arguments with respect to claims 15-18 and 24-32 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion


13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

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